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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970

No. 1439

ETHICON, INC.,

Petitioner,

v.

HANDGARDS, INC., ET AL.,

Respondents.

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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The petition should be denied. The asserted "Question Presented" (Pet. 2) is not in fact presented, there is no conflict with any decision of another Court of Appeals or applicable decision of this Court, and there is no special or important reason whatever for granting the petition.

REASONS FOR DENIAL

I. THE RULE OF THIS COURT'S DECISIONS

Petitioner misconceives the thrust of this Court's decisions.

While an introductory general comment did assert in *The Barbed Wire Patent,* 143 U.S. 275, 284 (1892) that "courts . . . have required that the proof shall be clear, satisfactory and beyond a reasonable doubt", this Court

went on (143 U.S. 275, 285-292) to make clear that the facts did not raise a "beyond a reasonable doubt" issue, and that the Court was not applying that standard.[1]

Then, in *Eibel Co.* v. *Paper Co.*, 261 U.S. 45, 60 (1923) [2], this Court specifically stated as the "rule that evidence to prove prior discovery must be *clear and satisfactory*".[3] Significantly, not only is this language harmonious with the standard in fact applied in *Barbed Wire*, but this Court cited immediately after the just-quoted language the very page of *Barbed Wire* which had included the "reasonable doubt" language.

Then came *Radio Corp.* v. *Radio Laboratories*, 293 U.S. 1 (1934), in which this Court after specifically observing that "[s]ometimes" "reasonable doubt" language has been used (293 U.S. 1, 7, citing inter alia *Barbed Wire*) said (Id. 8):

> "The context suggests that in these and like phrases the courts were not defining a standard in terms of scientific accuracy or literal precision, but were offering counsel and suggestion to guide the course of judgment. Through all the verbal variances, however, there runs this common core of thought and truth, that one otherwise an infringer who assails the validity of a patent fair upon its face

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[1] With respect to five different asserted prior uses, the Court said respectively that "we are far from being satisfied" that the first was of even approximately the same construction (143 U.S. 275, 289); that the weight of the evidence was actually against the second (Id. 289-290); that the evidence as to the third was "unworthy of belief" (Id. 290); that there was "conclusive answer" to evidence on the fourth (Id. 291); and that evidence as to the fifth was "improbable" (Id. 291) and did not "satisfy" (Id. 292). Of further yet different alleged prior uses, the Court said (Id. 292): "We are not satisfied. . . ."

[2] Not cited by petitioner.

[3] Emphasis ours throughout.

bears a heavy burden of persuasion, and fails unless his evidence has *more than a dubious preponderance.*"[4]

Plainly, even if (as it did not) *Barbed Wire* had made "reasonable doubt" a meaningful separate touchstone for prior use standard of proof, this Court has long since made it clear that it is not now one.

II. COURTS OF APPEALS NOT IN CONFLICT

Petitioner says that every Court of Appeals but that for the Ninth Circuit follows what petitioner chooses still to call "the rule of *The Barbed Wire Patent*"[5] (Pet. 7). If by that petitioner means the rule as clarified in *Radio Corp.*, the Ninth Circuit follows it too. If it means something more stringent than *Radio Corp.*, no more do other Courts of Appeal follow it, as how could they properly in view of *Radio Corp.*?

Petitioner finally explicitly traces the Ninth Circuit's "present defection" (Pet. 7) to *Tucker Aluminum Products, Inc.* v. *Grossman*, 312 F.2d 293, 294 (9 Cir. 1963)[6]:

> "We think the burden is successfully borne where there exists 'substantial evidence', which is *'clear and satisfactory'* although a defendant need not prove this defense 'beyond a reasonable doubt'."

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[4] Accord, using the "heavy burden of persuasion" verbal standard and citing *Radio Corp.* "and cases cited" therein, *Smith* v. *Hall*, 301 U.S. 216, 233 (1937).

[5] This characterization of the rule would seem misleading in emphasis, after *Radio Corp.* at least, as this Court's approach to citation in *Smith* (footnote 4, supra) confirms.

[6] One might think petitioner's "the singular exception of the Ninth Circuit's present defection" (Pet. 7) to refer only to the action at bar, were not *Tucker* excluded from the footnote listing decisions (Pet. 7-8), and were it not for what is later said of *Tucker* (Pet. 9-11).

This language, precisely that of *Eibel* (supra 2), was wholly harmonious with *Barbed Wire* as restated by *Radio Corp.* (as well as with *Barbed Wire's* facts and real approach, as already seen). Petitioner wrongly characterizes it as representing a "substantive change" (Pet. 10).

To the same substantial effect as *Tucker* (and this Court's decisions) are, not surprisingly, the decisions generally, including some cited in petitioner's long footnote (Pet. 7-8) [7] and others there ignored.[8] When the old introductory *Barbed Wire* language has crept in, typically almost in passing, there is (again, not surprisingly in view

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[7] In *Jones Knitting Corporation* v. *Morgan*, 361 F.2d 451, 455 (3 Cir. 1966), after referring to *Barbed Wire*, the Court quoted from "a more recent reappraisal" (i.e., *Radio Corp.*). In *Devex Corporation* v. *General Motors Corporation*, 321 F.2d 234, 239 (7 Cir. 1963), cert. den'd 375 U.S. 971, the standard enunciated was "clear and convincing".

[8] *Rooted Hair, Inc.* v. *Ideal Toy Corp.*, 329 F.2d 761, 765 (2 Cir. 1964: "heavy burden of proof . . . with clear and convincing evidence"), cert. den'd 379 U.S. 831; *Rokap Corporation* v. *Lamm*, 85 F.2d 873, 874 (4 Cir. 1936: approving in a short opinion the District Court's handling of the public use issue; the District Court's verbal standard had been "clear and satisfactory, and convincing", *Rokap Corporation* v. *Lamm*, 10 F.Supp. 219, 224, D.Md. 1935); *Stamicarbon, N.V.* v. *Escambia Chemical Corporation*, 430 F.2d 920, 924, 925 (5 Cir. 1970), cert. den'd 400 U.S. 944: "clear and convincing"; "Justice Cardozo thus recognized [in *Radio Corp.*] that in patent cases, at least, there is not such a great trichotomy among these three denominations for the standard of proof in this aspect of a patent case as there may be in other fields of the law."); *A. J. Industries, Inc.* v. *Dayton Steel Foundry Company*, 394 F.2d 357, 361 (6 Cir. 1968: "strong, clear and convincing"); *McGraw-Edison Co.* v. *Central Transformer Corp.*, 308 F2d 70, 78, (8 Cir. 1962: "clear, convincing and satisfactory evidence and by more than a mere preponderance"); *Insul-Wool Insulation Corp.* v. *Home Insulation*, 176 F.2d 502, 505 (10 Cir. 1949: "more than a dubious preponderance — . . . strong, clear and convincing").

of *Eibel, Radio Corp.*, and *Smith*) no indication that the precise issue here involved, and the later authorities bearing on it, were recognized and considered.[9]

III. ASSERTED "QUESTION" NOT PRESENTED

Even assuming (arguendo only) that this Court's later decisions left for "reasonable doubt" in a patent defense context meaningfulness over and beyond "clear and satisfactory" or "clear and convincing" or "more than a dubious preponderance", this petition cannot really present the asserted question (Pet. 2).

The District Court, upon the testimony "of a number of witnesses" (Pet. 15), including corroborating witnesses (Pet. 14), supported by "documentary evidence" (Pet. 15), found that invalidating prior use had been proven, saying (Pet. 15):

> "Evidence in support of this conclusion is found to be *not only clear and convincing, but beyond reasonable doubt.*"

It was in this context that the Court of Appeals said that "we have a case that could have been decided either way" (Pet. 13).

Petitioner reads the latter language as "equivocal" (Pet. 2), going so far as to say it "must be concluded that the Court waived defendant's statutory burden" of proof of its defense and shifted the burden to plaintiff (Pet. 11). This is plainly fanciful. To attribute to an experienced Court of Appeals violation of a rule every law school freshman knows, that the burden of proof of defense lies with defendants, would be extreme in any event. Here, it is plain in

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[9] E.g., *Atlas* v. *Eastern Airlines, Incorporated*, 311 F.2d 156, 160 (1 Cir. 1962), cert. den'd 373 U.S. 904; *Block* v. *Nathan Anklet Support Co.*, 9 F.2d 311, 313 (2 Cir. 1925).

context what the Court of Appeals meant — simply that the District Court's finding (then applied in conjunction with the applicable law) was not clearly erroneous (F.R.Civ. P. 52 (a)). So far as appears in the present case, the Court of Appeals was willing to assume as the District Court may have that that applicable law included continued special meaning for "reasonable doubt", an approach giving petitioner more than it was entitled to. There is certainly no indication it was applying a standard less than that of *Tucker Aluminum Products, Inc.* v. *Grossman,* 312 F.2d 293, 294 (9 Cir. 1963), which was before it and which is absolutely harmonious with the applicable decisions of this Court and other Courts of Appeals. To read the language of the Court of Appeals as altogether shifting the burden of proof only illustrates how petitioner strains to seek a petitionable question.

CONCLUSION

Certiorari should be denied for the foregoing reasons.

Respectfully submitted,

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